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09/640,037	08/16/2000	Daniel Schutzer	CITI0178	3173

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EXAMINER

GREENE, DANIEL L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/640,037

Applicant(s)

SCHUTZER, DANIEL

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 13,15,37 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12,14, 16-36,38,40-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/8/03 have been fully considered but they are not persuasive.
2. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Background" section) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the references do not teach or suggest that when the information about a consumer is different between the first times they registered and the second time they register, to update the consumer's information/data. Or, if the data on a consumer were different for the current transaction

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form the last transaction, the merchant would update their records/data concerning the customer. The primary reference, Mitra '878, teaches that the billing device and the seller continuously check and maintain current information regarding the consumer. The examiner submits that it would have been obvious to one having ordinary skill in the art at the time of the invention was made to compare past consumer data with present consumer data and make changes to data that is out of date or changed since it is known in the art that consumers move, change accounts, etc. that merchants must be current with to insure proper billing, delivery and service.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 20-39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitra et al. US20010014878 [Mitra], and further in view of Paltenghe et al. US 20010011250 [Paltenghe].

As per Claim 1.

Mitra discloses;

receiving an indication that an Internet user wishes to finalize a transaction with a web merchant; Col. 3, para. 0041

Mitra discloses the claimed invention except for the term "electronic wallet". Paltenghe teaches that an "electronic wallet" is a virtual container for the various information and financial application a user might want to be mobile. Although not required, one example of an implementation of the "wallet" is through the use of "smart card" technology of the type well known to those of ordinary skill in the art" Col.3, Para. 27. As taught by Paltenghe, the terminology "electronic wallet" is well known in the art and not to be considered as a unique or original limitation in associated claims. The examiner considers the Applicants use of the term "electronic wallet" to mean a virtual container of information resident on a user's computer to provide and receive information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to associate "electronic wallet" with blocks of data that could be transmitted and received for conducting business. presenting a first electronic wallet associated with the web merchant; Col.4, Para. 0047

automatically receiving in the first electronic wallet updated consumer information from a second electronic wallet associated with the Internet user. Col.5, Para. 0061

As per Claim 2.

Mitra further discloses;

wherein the first electronic wallet resides on a web server associated with the merchant. Col.2, para.0025

As per Claim 3.

Mitra further discloses;

wherein the second electronic wallet resides on a personal computer associated with the Internet user. Col. 2, Para. 0025.

As per Claim 4.

Mitra further discloses;

wherein the second electronic wallet resides on a web server. Col.2, Para. 0025.

As per Claim 5.

Mitra further discloses;

wherein the web server is associated with a third party. Col. 2,Para. 0026.

As per Claim 6.

Mitra further discloses:

wherein the second electronic wallet comprises an application residing on the personal computer. Col. 2, Para. 0025.

As per claim 7.

Mitra does not expressly teach where the first electronic wallet comprises the preferred electronic wallet of the merchant. The term "preferred" is deemed to be a non-functional descriptive term that cannot exhibit any functional interrelationship with the way the electronic wallet is used and does not constitute a statutory process, machine, manufacture or composition of matter. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to designate the merchant's electronic wallet any thing they wanted because such data does not alter how the electronic wallet functions and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 8.

Mitra does not expressly teach where the first electronic wallet comprises the exclusive electronic wallet of the merchant. The term "exclusive" is deemed to be a non-functional descriptive term that cannot exhibit any functional interrelationship with the way the electronic wallet is used and does not constitute a statutory process, machine, manufacture or composition of matter. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability; see *In re Gulack*, 703

F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983); in re Lowry, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to designate the merchant's electronic wallet any thing they wanted because such data does not alter how the electronic wallet functions and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per Claim 9.

Mitra further discloses:

identifying the Internet user. Col. 2, Para. 0030.

As per Claim 10.

Mitra further discloses;

wherein the step of identifying the Internet user comprises accessing a cookie present in the personal computer. Col. 5, Para. 0060.

As per Claim 11.

Mitra further discloses;

wherein the step of identifying the Internet user comprises receiving a user name and password associated with the Internet user. Col. 6, Para 0067.

As per Claim 12.

Mitra further discloses;

accessing stored consumer data associated with the Internet user previously provided by the Internet user. Col. 6, Para. 0067.

As per Claim 14.

Mitra further discloses;

populating the first electronic wallet with the stored consumer data. Col.7, Para. 0071.

As per Claim 20.

Mitra further discloses;

communicating a request for payment from a financial payment engine. Col. 3, Para. 0041, 0042.

As per Claim 21.

Mitra discloses;

identifying an Internet consumer accessing a web site of a merchant; Col. 3, Para. 0041

accessing consumer data associated with the Internet consumer previously provided by the Internet consumer and stored in a database; Col.6, Para. 0067
receiving an indication that the Internet consumer wishes to finalize payment associated

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with a web site transaction at the web site of the merchant; Col.3, Para.0041 Mitra discloses the claimed invention except for the term "electronic wallet". Paltenghe teaches that an ""electronic wallet" is a virtual container for the various information and financial application a user might want to be mobile. Although not required, one example of an implementation of the "wallet" is through the use of "smart card" technology of the type well known to those of ordinary skill in the art" Col.3, Para. 27. As taught by Paltenghe, the terminology "electronic wallet" is well known in the art and not to be considered as a unique or original limitation in associated claims. The examiner considers the Applicants use of the term "electronic wallet" to mean a virtual container of information resident on a user's computer to provide and receive information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to associate "electronic wallet" with blocks of data that could be transmitted and received for conducting business.

presenting a first electronic wallet having the consumer data associated with the Internet consumer populated in the first electronic wallet; Col. 7, Para. 0071. automatically receiving in the first electronic wallet updated consumer information from a second electronic wallet, wherein the second electronic wallet comprises an electronic wallet on the consumer's computer having the updated consumer information. Col. 5, Para. 0061.

As per claim 22.

Mitra does not expressly teach where the first electronic wallet comprises the preferred electronic wallet of the merchant. The term "preferred" is deemed to be a non-functional descriptive term that cannot exhibit any functional interrelationship with the way the electronic wallet is used and does not constitute a statutory process, machine, manufacture or composition of matter. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to designate the merchant's electronic wallet any thing they wanted because such data does not alter how the electronic wallet functions and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 23.

Mitra does not expressly teach where the first electronic wallet comprises the exclusive electronic wallet of the merchant. The term "exclusive" is deemed to be a non-functional descriptive term that cannot exhibit any functional interrelationship with the way the electronic wallet is used and does not constitute a statutory process, machine, manufacture or composition of matter. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703

F.2d 1381, 217 USPQ 409 (Fed. Cir. 1983); In re Lowry, 32 F. 3d ~ 579, 32 USPQ2d 1031 (Fed. Cir. 9994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to designate the merchant's electronic wallet any thing they wanted because such data does not alter how the electronic wallet functions and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per Claim 24.

Mitra further discloses;

communicating a request for payment from a financial payment engine. Col. 3, Para. 0041, 0042.

As per Claim 25.

Mitra discloses;

means for receiving an indication that an Internet user wishes to finalize a transaction with a web merchant; Col. 3, Para. 0041.

Mitra discloses the claimed invention except for the term "electronic wallet". Paltenghe teaches that an "electronic wallet" is a virtual container for the various information and financial application a user might want to be mobile. Although not required, one example of an implementation of the "wallet" is through the use of "smart card" technology of the type well known to those of ordinary skill in the art" Col.3, Para.

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27. As taught by Paltenghe, the terminology "electronic wallet" is well known in the art and not to be considered as a unique or original limitation in associated claims. The examiner considers the Applicants use of the term "electronic wallet" to mean a virtual container of information resident on a user's computer to provide and receive information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to associate "electronic wallet" with blocks of data that could be transmitted and received for conducting business.

means for presenting a first electronic wallet associated with the web merchant;

Col.4, Para. 0047

means for automatically receiving in the first electronic wallet updated consumer information from a second electronic wallet associated with the Internet user. Col.5, Para. 0061.

As per Claim 26.

Mitra further discloses;

wherein the first electronic wallet resides on a web server associated with the merchant. Col. 2, Para. 0025.

As per Claim 27.

Mitra further discloses;

wherein the second electronic wallet resides on a personal computer associated with the Internet user. Col. 2, Para. 0025.

As per Claim 28.

Mitra further discloses;

wherein the second electronic wallet resides on the web server. Col. 2, Para. 0025.

As per Claim 29.

Mitra further discloses;

wherein the web server is associated with a third party. Col. 2, Para. 0026.

As per Claim 30.

Mitra further discloses;

wherein the second electronic wallet comprises an application residing on the personal computer. Col. 2, Para. 0025.

As per claim 31.

Mitra does not expressly teach where the first electronic wallet comprises an electronic wallet of a third party. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to designate the third parties electronic wallet any thing they wanted because such data does not alter how the electronic wallet functions and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 32.

Mitra does not expressly teach where the first electronic wallet comprises an electronic wallet of the merchant.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to designate the merchant's electronic wallet any thing they wanted because such data does not alter how the electronic wallet functions and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per Claim 33.

Mitra further discloses;

means for identifying the Internet user. Col. 2, Para. 0030.

As per Claim 34.

Mitra further discloses;

wherein the means for identifying the Internet user comprises means for accessing a cookie present in the personal computer. Col. 5, Para. 0060.

As per Claim 35.

Mitra further discloses;

wherein the means for identifying the Internet user comprises means for receiving a user name and password associated with the Internet user. Col. 6, Para. 0067.

As per Claim 36.

Mitra further discloses;

means for accessing stored consumer data associated with the Internet user previously provided by the Internet user. Col. 6, Para. 0067.

As per Claim 38.

Mitra further discloses;

means for populating the first electronic wallet with the stored consumer data. Col.7, Para. 0071.

As per claim 44.

Mitra further discloses;

means for communicating a request for payment from a financial payment engine. Col. 3, Para. 0041, 0042.

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Claims 16-19, 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitra and Paltenghe as applied to claims 1-15, 20-39 and 44 above, and further in view of Kawan US 5,796,832 [Kawan].

As per Claim 16.

Mitra discloses the claimed invention except for the wherein the second electronic wallet comprises a personal digital assistant. Kawan teaches that it is known to have a financial information and transaction system, which utilizes wireless communication in connection with portable terminals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a personal digital assistant, which is a portable terminal, as taught by Kawan, since Kawan states at Col. 1, lines 5967 that such a modification would provide transaction and information terminals which can be conveniently repositioned by the operator as necessary to maximize availability and use of the financial services provided thereby.

As per claim 17:

Mitra discloses the claimed invention except for the wherein the second electronic wallet comprises a telephone. Kawan teaches that it is known to have a financial information and transaction system, which utilizes wireless communication in connection with portable terminals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a telephone, as taught by Kawan, since Kawan states at Col. 1, lines 59-67 that such a modification would provide

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transaction and information terminals which can be conveniently repositioned by the operator as necessary to maximize availability and use of the financial services provided thereby.

As per Claim 18.

Mitra discloses the claimed invention except for the wherein the telephone comprises a portable telephone. Kawan teaches that it is known to have a financial information and transaction system, which utilizes wireless communication in connection with portable terminals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a portable telephone, as taught by Kawan, since Kawan states at Col. 1, lines 59-67 that such a modification would provide transaction and information terminals which can be conveniently repositioned by the operator as necessary to maximize availability and use of the financial services provided thereby.

As per claim 19:

Mitra discloses the claimed invention except for the wherein the portable telephone comprises a cellular telephone. Kawan teaches that it is known to have a financial information and transaction system, which utilizes wireless communication in connection with portable terminals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a cellular telephone, as taught by Kawan, since Kawan states at Col. 1, lines 59-67 that such a modification

would provide transaction and information terminals which can be conveniently repositioned by the operator as necessary to maximize availability and use of the financial services provided thereby.

As per Claim 40.

Mitra discloses the claimed invention except for the wherein the second electronic wallet comprises a personal digital assistant. Kawan teaches that it is known to have a financial information and transaction system, which utilizes wireless communication in connection with portable terminals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a personal digital assistant, which is a portable terminal, as taught by Kawan, since Kawan states at Col. 1, lines 59-67 that such a modification would provide transaction and information terminals which can be conveniently repositioned by the operator as necessary to maximize availability and use of the financial services provided thereby.

Mitra discloses the claimed invention except for the wherein the second electronic wallet comprises a telephone. Kawan teaches that it is known to have a financial information and transaction system, which utilizes wireless communication in connection with portable terminals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a telephone, as taught by Kawan, since Kawan states at Col. 1, lines 59-67 that such a modification would provide transaction and information terminals which can be conveniently repositioned by the

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operator as necessary to maximize availability and use of the financial services provided thereby.

As per claim 41:

Mitra discloses the claimed invention except for the wherein the second electronic wallet comprises a telephone. Kawan teaches that it is known to have a financial information and transaction system, which utilizes wireless communication in connection with portable terminals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a telephone, as taught by Kawan, since Kawan states at Col. 1, lines 59-67 that such a modification would provide transaction and information terminals which can be conveniently repositioned by the operator as necessary to maximize availability and use of the financial services provided thereby.

As per Claim 42.

Mitra discloses the claimed invention except for the wherein the telephone comprises a portable telephone. Kawan teaches that it is known to have a financial information and transaction system, which utilizes wireless communication in connection with portable terminals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a portable telephone, as taught by Kawan, since Kawan states at Col. 1, lines 59-67 that such a modification would provide transaction and information terminals which can be conveniently

repositioned by the operator as necessary to maximize availability and use of the financial services provided thereby.

Mitra discloses the claimed invention except for the wherein the portable telephone comprises a cellular telephone. Kawan teaches that it is known to have a financial information and transaction system, which utilizes wireless communication in connection with portable terminals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a cellular telephone, as taught by Kawan, since Kawan states at Col. 1, lines 59-67 that such a modification would provide transaction and information terminals which can be conveniently repositioned by the operator as necessary to maximize availability and use of the financial services provided thereby.

As per claim 43:

Mitra discloses the claimed invention except for the wherein the portable telephone comprises a cellular telephone. Kawan teaches that it is known to have a financial information and transaction system, which utilizes wireless communication in connection with portable terminals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a cellular telephone, as taught by Kawan, since Kawan states at Col. 1, lines 59-67 that such a modification would provide transaction and information terminals which can be conveniently repositioned by the operator as necessary to maximize availability and use of the financial services provided thereby.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

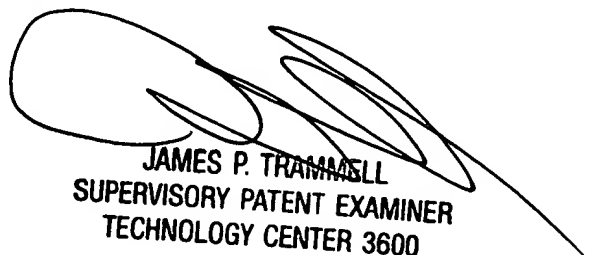
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703.306.5539. The examiner can normally be reached on M-Thurs. (8:00-5:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703.305.9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305-7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.3081113.

DLG

February 6, 2003



JAMES P. TRAMMELL
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